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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,246	02/26/2002	Bruce H. Hanson	SWIM-018/00US	3482
7055	7590	10/18/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			JOHNSON, JERROLD D	
			ART UNIT	PAPER NUMBER

3728

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/082,246	Applicant(s) HANSON ET AL.	
	Examiner Jerrold Johnson	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 10-14, 16, 17 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-14, 16, 17 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Drawings

DETAILED ACTION

Drawings

The corrected drawing is approved.

Claim Rejections - 35 USC § 112

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 is not understood. It is not understood how the two constraining walls can define two open sides. Do the two constraining walls constitute closed sides opposite which there are open sides? Or, are the two constraining walls "open." Claim 23 also sets forth a first binding member extending from a bottom edge of one of the open sides. There is no support for this recitation in the specification and the Examiner is uncertain as to what is the bottom edge to which this recitation refers.

Claim Rejections - 35 USC § 102/103

35 USC § 102(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

35 USC § 103(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1,2,4,5,12,14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by McDonald US 1,286,374 or in the alternative under 35 U.S.C. 103(a) as being unpatentable over McDonald.

McDonald discloses a flat mail sleeve packaging system suitable for the intended use to stack product with bound edges in a constrained homogenous mass, comprising: a first constraining wall A having a first constraining surface; and a second constraining wall B having a second constraining surface, the second constraining wall being positioned with respect to the first constraining wall at a substantially perpendicular angle thereto, wherein the first and second constraining walls are adapted for having the product placed therebetween with the bottom edges of the product all facing in a same direction without collapsing.

Note that although McDonald does not specifically show stacked product having bound edges, his flat mail sleeve packaging system is inherently capable of having a product with bound and non-bound edges placed therebetween with the bottom edges and the bound and non-bound edges of the product all facing in a same direction without collapsing. Bound product of a size which would fit within the sleeve of McDonald are well known.

The recitation "a portion of one of the first and second constraining walls being folded over to form an end cap that is adapted to protect an end product of the stack and add rigidity to the flat mail sleeve packaging system" is being treated as a product by process limitation. As set forth in MPEP 2113, product by process claims are not limited to the manipulations of the recited steps, only to the structure implied by the steps once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to the applicant to show an unobvious difference. Thus, even though McDonald is silent as to the process to manufacture the end cap, it appears that the end cap would be the same or similar as that claimed.

In the alternative, it appears that the system of McDonald has been manufactured using a folding method, where a single sheet of material is folded to the final shape. Note the folded over edges A' and M, as well as the corner connecting the constraining walls A and B. Accordingly, it would have been obvious to one of ordinary skill in the art to have manufactured the end cap C from folding over a portion of A or B, just as the fold at A' has been formed by folding over A.

Re claim 2, the sleeve further comprises a first binding member E extending between a length of one of the first and second constraining walls.

Re claim 4, the first and second constraining walls form a corner therebetween that is adapted to conform to a corner of the product.

Re claim 5, the combination of the sleeve and a bound product has not been set forth (see 112 2nd paragraph rejection above). The claim is interpreted as further

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defining the intended use of the sleeve. Additionally, bound products of a size which would fit within the sleeve of McDonald are well known. And, McDonald is inherently capable of having such a bound product stacked thereon such that "a width of the first and second constraining walls is at least equal to a bound edge and the non bound edge of the product stacked thereon.

Re claim 12, here again the combination of the sleeve and a bound product has not been set forth (see 112 2nd paragraph rejection above). Bound products of a size which would fit within the sleeve of McDonald are well known. And, McDonald is inherently capable of having such a bound product stacked thereon such that "each width of the first and second constraining walls is at least equal to the bound edge and the non bound edge of the product stacked thereon, the first and second constraining walls are adapted for having the product placed therebetween with the bound edges of the product all facing in a same direction."

Re claim 14, see the rejection of claim 12. McDonald is inherently capable of having such a bound product stacked thereon such that "the width of the first and second constraining walls is larger than the bound edge and the non bound edge of the product stacked thereon." Or in other words, there are many examples of bound product which would fit within these size constraints with respect to the sleeve of McDonald.

Re claim 16, the first binding member E extends along the length of the second constraining wall B.

Claim Rejections - 35 USC § 103

Claims 3, 13 and 23 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald in view of Jacobsmeyer US D415,730.

McDonald does not disclose a second binding member.

Jacobsmeyer discloses in Figs. 9 and 10 the use of perpendicular first and second straps.

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the sleeve of McDonald to include a second strap as taught by Jacobsmeyer so as to provide additional stability to a stack of the product, particularly during times that the sleeve is in transit, so as to prevent the product from falling from the sleeve.

Jacobsmeyer does not show the stacked product in the same orientation as claimed with respect to the sleeve, but does indeed show that the size of the sleeve first and second sides is greater than the corresponding dimensions of the product.

Jacobsmeyer also shows binding members such as the vertically disposed binding member in Fig. 10 extending from a bottom edge of one side to a bottom edge of the other open side.

Claim Rejections - 35 USC § 102

Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Christensen US 1,381,904.

Christensen discloses in Fig. 1 a packaging system adapted to stack product with bound and unbound edges in a constrained homogenous mass comprising an upper extending constraining wall 11 on upper section B, a bottom constraining wall 10 in lower section C, end portions 13 and 17 folded over to form end caps, first and second binding members 21 perpendicular to each other. The length of 11 is greater than the width as set forth in claim 22.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDJ



Mickey Yu
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